

## **REMARKS**

### **A. INTRODUCTION**

Claims 1-44, 46-50, 56-62, and 65-80 are pending and rejected.

Upon entry of this Amendment:

- Claims 1, 41, 42, 49, 56-62, and 65-80 will be pending
- Claims 1, 41, 42, 49, 56, 61, 62, and 65 will be amended
- Claims 2-40, 43, 46-48, and 50 will be cancelled without prejudice
- Claims 1, 56, 61, 62, 71, 72, and 75-80 will be the only independent claims

### **B. TELEPHONE INTERVIEW**

Applicants are grateful for the Examiner's courtesy in participating in a Telephone Interview on February 13, 2008 with Applicants' representative.

Applicants' representative and the Examiner discussed generally how various embodiments described in the Specification allow for an offer to a customer from a second merchant to be interjected during a transaction with a first merchant in a manner such that the customer's obligation (and/or the identity of the second merchant) will be unknown to the customer unless and until the customer initiates consummation of the transaction (e.g., initiates a "checkout" process for an item the customer wants to purchase).

Applicants' representative stated that although Katz generally suggests "upselling" another product/service by the same merchant with whom the customer is processing a transaction for a first item, no combination of the cited references relied upon teaches or suggests allowing a second merchant to become involved at that point in the process (and not before, as in a pre-packaged combination of products).

During the Telephone Interview, some potential amendments were discussed. The Examiner generally suggested that where Applicants so desired in order to claim particular desired embodiments, Applicants should amend independent Claim 1 to recite explicitly any relative timing of steps as Applicants found appropriate. The Examiner also suggested that Applicants amend independent Claim 1 to clarify explicitly, if desirable to Applicants, that an offer for a second merchant for a benefit to be applied to a transaction with a first merchant does not comprise a pre-packaged or "combo" offer.

Although no formal agreement was reached with respect to allowable subject matter, Applicants are grateful to the Examiner for taking the time to discuss the subject matter of this Application and the pending claims in light of the cited references.

If the Examiner has any questions about the Amendment being presented with this Response in light of the Telephone Interview, the Examiner is encouraged to contact Mike Downs at (203) 461-7292, at the Examiner's convenience.

**C. SECTION 103(A) REJECTIONS**

Claims 1-19, 33, 42-44, 49, 56-60, 62-64, 71-76 and 79-80 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (U.S. Patent No. 6,055,513), and further in view of Logan (U.S. Patent No. 5,721,827) and Donlon (Brian Donlon, *USA Today*, "Cable industry channels its efforts in April; sampler of specials").

Claims 29-32, 61, 65 and 77-78 are stand rejected as being unpatentable over Katz, Donlon or Discount Store News and Logan and further in view of Spoor (Dana Spoor, *Cellular Business*, pp. 58-62, February 1994).

Claims 34-40 stand rejected as being unpatentable over Katz, Donlon or Discount Store News and in further view of Saxe (U.S. Patent No. 5,936,346)

Claims 20-28, 41, 46-48 and 50 stand rejected as being unpatentable over Katz, Donlon or Discount Store News and Logan and in further view of Weinblatt (U.S. Patent No. 5,515,270).

Claim 66 stands rejected as being unpatentable over Katz, Donlon or Discount Store News, Logan and Spoor and in further view of Tedesco (Broadcasting & Cable).

Claim 67-68 stand rejected as being unpatentable over Katz, Donlon or Discount Store News, Logan and Spoor and in further view of Fleming (Wall Street Journal).

Claims 69-70 stand rejected as being unpatentable over Katz, Donlon or Discount Store News, Logan and Spoor and in further view of Colman (Broadcasting & Cable).

We respectfully traverse the Examiner's Section 103(a) rejection.

Nonetheless, Claims 2-40, 43, 46-48, and 50 will be cancelled without prejudice solely in order to streamline prosecution and expedite allowance of the present application. Applicants intend to pursue subject matter as it was previously claimed in this application (and/or other subject matter that might not yet have been claimed) in one or more continuing applications.

**1. Claims 56-60 and 73-76**

Independent Claim 56 has been amended to provide for *receiving an indication that a customer initiated a checkout process to consummate purchase of at least one item ~~that a customer is ready to purchase~~ from a merchant via a web site, the at least one item having an associated total price for only the at least one item*, clarifying that in accordance with one desired embodiment, the customer initiates a checkout process and the total price is not associated with a prepackaged or “combo” offer (e.g., in contrast to the “cross-selling” references cited by the Examiner).

Further, independent Claim 56 now recites  
in response to the received indication, transmitting a web page including  
an indication of the at least one item to be purchased,  
an indication of the associated total price for the at least one item,  
a first selectable button associated with a first option for the customer  
to pay the associated total price for the at least one item, and  
a second selectable button associated with a second option for the  
customer to receive an offer for a reduction of the associated total price;  
after transmitting the web page, receiving a signal indicating selection by the  
customer of the second selectable button of the web page.

No combination of the cited references teaches or suggests a web page allowing for a choice between paying the associated total price or receiving an offer for a reduction in the total price, as described in the Specification (e.g., FIGs. 10 and 11 and accompanying text). Applicants submit that no combination of the cited references provides for the recited combination of features, nor do the cited references evidence an apparent reason to provide for that specific combination.

Claims 75 and 76 are directed to a computer readable medium and an apparatus, respectively, that by reference allow for the functionality recited in the method of Claim 56. Accordingly, Applicants submit that independent Claims 56, 75, and 76 (and dependent Claims 57-60, 73 and 74) contain allowable subject matter.

**2. Claims 1, 41, 42, 49, 71, and 72**

Independent Claim 1 has been amended to provide explicitly for particular embodiments of steps as previously recited. Although the changes are extensive,

the Examiner will understand that independent Claim 1 is consonant with the broader embodiment claimed previously.

Applicants submit that no combination of the cited references provides for the recited combination of features, nor do the cited references evidence an apparent reason to provide for that specific combination.

Claims 71 and 72 are directed to a computer readable medium and an apparatus, respectively, that by reference allow for the functionality recited in the method of Claim 1.

Accordingly, Applicants submit that independent Claims 1, 71, and 72 (and dependent Claims 41, 42, and 49) contain allowable subject matter.

**3. Claim 61, 66-70, 77, and 78**

Similarly, independent Claim 61 has been amended to recite *in which the purchase does not include any item that requires a service agreement for its use; and providing an offer for the subsidy from the second merchant, the step of providing the offer being performed before the purchase is consummated but only after receiving the indication that the customer is willing to make a purchase from the first merchant, whereby the offer is not provided unless and until the indication is received.* Applicants submit that no combination of the cited references provides for the recited combination of features, nor do the cited references evidence an apparent reason to provide for that specific combination.

New Claims 77 and 78 are independent claims and are directed to a computer readable medium and an apparatus, respectively, that by reference allow for the functionality recited in the method of Claim 61. Accordingly, Applicants submit that independent Claims 61, 77, and 78 (and dependent Claims 66-70) contain allowable subject matter.

**4. Claims 62, 79, and 80**

Independent Claim 62 has not been amended. Claim 62 recites *after activating the button, receiving a signal that the customer has clicked the button; and providing, in response to the received signal, an offer for a subsidy from the second merchant, the step of providing the offer being performed before the purchase is consummated but only after receiving the signal that the customer has clicked the button, whereby the offer is not provided unless and until the signal is received.*

The Examiner does not address any of the above explicit limitations related to activation of a button and functions performed only after receiving a signal is received that the customer has clicked the button. For at least this reason, no prima

facie case of obviousness has been provided for independent Claims 62, 79, and 80. Further, Applicants submit that no combination of the cited references provides for the recited combination of features, nor do the cited references evidence an apparent reason to provide for that specific combination.

Accordingly, Applicants request reconsideration and allowance of independent Claims 62, 79, and 80.

**D. ADDITIONAL COMMENTS**

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

**E. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES**

We understand that a three-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$1050.00

Deposit Account: 50-0271

Order No.: 98-109

Please credit any overpayment to the same account.

**F. CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

Respectfully submitted,

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